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REMARKS

Claims 1-18 were pending in the application prior to this response. Claims 1, 3, 4, 8 and 18 have been amended herein. Claims 2, 5-7 and 9-17 remain in the application unchanged by this response. Accordingly, claims 1-18 will remain pending after entry of the amendment presented herein. Reexamination and reconsideration are requested.

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**I. Amendments to Claims 1, 3, 4, 8 and 18**

Claims 1, 3, 4, 8 and 18 have been amended herein to replace the term "image capture unit" with the term "imaging device". This amendment is presented to provide better consistency with the terminology of the specification. No new matter has been added.

**II. Rejection of Claims 1, 2, 8, 16 and 18 Under 35 U.S.C. §102(e)**

Claims 1, 2, 8, 16 and 18 stand rejected under 35 U.S.C. §102(e) as being anticipated by Dunton et al. (U.S. Patent No. 6,151,069).

Reconsideration of the Examiner's rejection is requested.

Independent claim 1, as amended herein, recites the following:

A digital image processor for use in a digital camera having an imaging device arranged to output digital images and a memory for storing digital images, the digital image processor comprising:

**a preprocessor comprising hardware for preprocessing digital images received from the imaging device and storing the digital images in the memory; and**

**a postprocessor comprising hardware arranged to receive digital images and to postprocess the digital images into a viewable form.**

(bold emphasis added)

The Examiner takes the position that applicant's recited preprocessor and postprocessor are met by the Dunton et al. correction block 210 and compression logic block 212, respectively (see, e.g., Dunton et al., Fig. 2). The Examiner takes the further position that the Dunton et al. correction block 210 stores "digital images in a memory (local storage device 122 via local

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storage interface 350)" (Office action, page 2).

Applicant's claim 1, however, specifically recites the following regarding the preprocessor:

a preprocessor comprising hardware for preprocessing digital images received from the imaging device and storing the digital images in the memory;

Claim 1, thus, requires that the recited preprocessor hardware be at least capable of preprocessing digital images *and storing the preprocessed digital images in memory*. In the Dunton et al. device, however, data from the correction block 210 can *only* be sent to the compression logic block 212 and, thus, not to a storage device.

Specifically, with reference to Fig. 2 of Dunton et al., it can be seen that the correction block 210 can only pass data to the compression logic block 212 (via the path indicated by the un-numbered arrow labeled "DATA 8 bits"). The correction block 210 cannot transmit data to the local storage interface 350 or to the bus 242.

It is noted that a further connection is illustrated in Fig. 2 of Dunton et al. (by an un-numbered double-headed arrow) between the LUT (look up table) attached to the correction block 210 and the bus 242. Dunton et al. discloses, however, that this connection is provided to allow the system controller to program parameters into the LUT:

To further facilitate software control of the different modes of operation in this architecture, a number of memory-mapped control registers (not shown) may be coupled to the bus 242 to allow the system controller 160 to configure the apparatus 100 and the system 200 with the desired mode of operation. **Instructions can be provided for execution by the system controller to access the LUTs, RAM, and control registers via the bus 242 in order to program the parameters needed for the proper image processing methodologies of the selected mode of operation.**

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(Dunton et al., column 7, lines 46-56, bold emphasis added)

Thus, the double-headed arrow at the left side of Dunton et al. Fig. 2 illustrates a connection between the correction block 210 LUT and the bus 242 for purposes of allowing the system controller 160 to program or configure the LUT. The illustrated arrow does not indicate a path for image data from the correction block 210 to the bus 242. As discussed above, the correction block 210 can only send image data to the compression block 212 (via the arrow labeled "DATA 8 bits").

As discussed above, the output of the Dunton et al. correction block 210 is directly connected *only* to the compression logic block 212. The output of the compression logic block 212, in turn, is indirectly coupled to the local storage interface 350 (via, e.g., the data packing block 226, data path 16b, data flow controller 238 and the bus 242). This arrangement, however, does not meet the limitations of applicant's claims. Again, applicant's claim 1, recites, for example, the following regarding the preprocessor:

a preprocessor comprising hardware for preprocessing digital images received from the imaging device and storing the digital images in the memory;

Claim 1, thus, requires that the recited preprocessor hardware be at least capable of preprocessing digital images *and storing the preprocessed digital images in memory*.

Since the Dunton et al. compression logic block 212 (as well as other downstream devices) further processes the data leaving the correction block 210, the image data eventually reaching the storage interface device 350 is not the same image data that leaves the correction block 210. Thus, Dunton et al. does not disclose "a preprocessor comprising hardware for

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preprocessing digital images received from the imaging device and storing the digital images in the memory" as recited in applicant's claim 1.

For at least the reasons advanced above, applicant respectfully asserts that claim 1 is not anticipated by Dunton et al.

Claims 2, 8, 16 and 18 are allowable at least as depending from allowable base claim 1.

### III. Rejection of Claims 3-7 Under 35 U.S.C. §103(a)

Claims 3-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dunton et al. (U.S. Patent No. 6,151,069) in view of Takizawa et al. (U.S. Patent No. 6,388,706). Reconsideration of the Examiner's rejection is requested.

Claims 3-7 are allowable at least as ultimately depending from allowable base claim 1. Claims 3-7 are allowable on further independent grounds for the reasons advanced below.

Applicant respectfully asserts that a *prima facie* case of obviousness has not been established with respect to claims 3-7 because there is no motivation to combine the Dunton et al. and Takizawa et al. references as proposed by the Examiner. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkio Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner states the following on page 4 of the Office action:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the color interpolator of Takizawa with the postprocessor of Dunton. One would have been motivated to do so because it is advantageous to provide a color

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interpolator in a processing section so as to allow for excellent color reproduction and sharpness, and performing such color interpretation during post processing enables any sensor-specific defects to be corrected during preprocessing, thus producing a more accurately corrected image.

The Examiner, thus, asserts that various advantages would flow from combining the references, as proposed. Applicant respectfully points out, however, that such an assertion by the Examiner is insufficient to support the instant rejection; to properly establish a *prima facie* case of obviousness, the motivation to combine references must come *from the prior art*.

To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation **in the prior art** to make the specific combination that was made by the applicant.

*In re Raynes*, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993) (bold emphasis added)

The Examiner's assertion of alleged advantages represents the Examiner's *unsupported conclusion*. Such an *unsupported conclusion* cannot serve as the *evidence* required to support a combination of references when establishing a *prima facie* case of obviousness:

Whether the Board relies on an express or an implicit showing [of a motivation, suggestion or teaching to modify the teachings of a reference], it must provide particular findings related thereto.... **Broad conclusory statements standing alone are not "evidence"**.

*In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)) (bold emphasis added)

For the reasons advanced above, applicant respectfully asserts that the rejection of claims 3-7 is improper and should be withdrawn.

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#### IV. Rejection of Claim 17 Under 35 U.S.C. §103(a)

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Dunton et al. (U.S. Patent No. 6,151,069) in view of Fukushima et al. (U.S. Patent No. 6,253,023). Reconsideration of the Examiner's rejection is requested.

Claims 17 is allowable at least as ultimately depending from allowable base claim 1. Claim 17 is allowable on further independent grounds for the reasons advanced below.

Applicant respectfully asserts that a *prima facie* case of obviousness has not been established with respect to claim 17 because there is no motivation to combine the references as proposed by the Examiner. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner states the following on pages 5-6 of the Office action:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the ability to bypass the postprocessing step, as shown by Fukushima, with the image processing of Dunton. One would have been motivated to do so because by bypassing postprocessing in certain instances, unnecessary compression and other processing (such as when high-resolution images are desired) can be avoided, and thus total processing time can be greatly reduced.

The Examiner, thus, asserts that various advantages would flow from combining the Dunton et al. and Fukushima et al. references, as proposed. Applicant respectfully points out, however, that such an assertion by the Examiner is insufficient to support the instant rejection. As pointed out above, with respect to the rejection of claims 3-7, to establish a *prima facie* case of

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obviousness, the motivation to combine references must come *from the prior art*. An *unsupported conclusion* advanced by the Examiner cannot serve as the *evidence* required to support a combination of references when establishing a *prima facie* case of obviousness.

**V. Allowable Subject Matter**

On page 6 of the Office action, the Examiner objects to claims 9-15, indicating that these claims would be allowable if rewritten in independent form.

In view of the above, all of the claims are believed to be in condition for allowance. Re-examination and reconsideration are requested.

Respectfully submitted,

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